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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,690	11/17/2000	Harri Honko	915-376	8369

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WARE FRESSOLA VAN DER SLUYS &  
ADOLPHSON, LLP  
BRADFORD GREEN BUILDING 5  
755 MAIN STREET, P O BOX 224  
MONROE, CT 06468

EXAMINER

BATES, KEVIN T

ART UNIT PAPER NUMBER

2155

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/700,690

Applicant(s)

HONKO ET AL.

Examiner

Kevin Bates

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 13, 14, 21-27 and 44-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 13-14, 21-27, and 44-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5-18-2004
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office Action is in response to a communication made on May 18, 2004.

The Information Disclosure Statement was received on May 18, 2004.

Claims 1-7, 13-14, 21-27, and 44-77 are pending in this application.

#### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 21, 44-45, 52-53, 56, and 69-71 are rejected under 35 U.S.C. 102(b) as being anticipated by DiCecco (5452287).**

Regarding claims 1, 21, and 56, DiCecco discloses a switch for establishing a call between a calling terminal of an originating network and a recipient terminal of a terminating network (Column 2, lines 27 – 36), the switch comprising: an input for receiving a request from the originating network to set up a call with the recipient terminal (Column 2, lines 51 – 57), the recipient terminal operable in a single numberings scheme that enables the recipient terminal to receive different selectable call types from the calling terminal using a single telephone number to address the recipient terminal (Column 3, lines 20 – 27); an output for sending a call set-up message to the recipient terminal, said call set-up message comprising a bearer capability information element for indicating a type of call to be set up between the

calling terminal of the originating network and the recipient terminal (Column 2, lines 55 – 59); and connection means for completing a connection between the terminals (Column 2, lines 61 – 65; Column 3, lines 8 – 11), wherein the switch is arranged to send a call set-up message containing an empty bearer capability information element to the recipient terminal to inform the recipient terminal that the terminating network is not able to provide the recipient terminal with information from the originating network about the type of call to be set-up (Column 3, line 67 – Column 4, line 20).

Regarding claim 44 and 52, DiCecco discloses an input for receiving a call confirmation message from the recipient terminal, the call confirmation message comprising an indication of call types supported by the recipient terminal and bearer capability information indicating bearer services supported by the recipient terminal (Column 2, lines 19 – 21; Column 1, lines 15 – 25).

Regarding claim 45 and 53, DiCecco discloses an input for receiving call identification information from the originating network; means for interpreting the received call identification information; and means for setting up a connection between the terminating network and the terminal in the originating network with a commonly agreed data modulation rate (Column 2, lines 19 – 21; Column 1, lines 15 – 25; Column 4, lines 25 – 27).

Regarding claim 69, DiCecco discloses A recipient terminal comprising: means for receiving a call from a calling terminal in an originating network via a terminating network (Column 2, lines 51 – 57); and means for receiving from the terminating network a call set-up message comprising a bearer capability information element for

indicating a type of call to be set up with a calling terminal (Column 2, lines 55 – 59), wherein the recipient terminal is able to interpret a call set-up message containing an empty bearer capability information element as an indication that the terminating network is not able to provide the recipient terminal with information from the originating network about the type of call to be set up (Column 3, line 67 – Column 4, line 20).

Regarding claim 70, DiCecco discloses that the recipient terminal is able to send a call confirmation message to the terminating network in response to receipt of a call set-up message containing an empty bearer capability information element, the call confirmation message comprising an indication of call types supported by the recipient terminal and bearer capability information indicating bearer services supported by the recipient terminal (Column 3, line 67 – Column 4, line 20).

Regarding claim 71, DiCecco discloses a single numbering scheme that enables the recipient terminal to receive different selectable call types from the calling terminal using a single telephone number to address the recipient terminal (Column 3, lines 20 – 22).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-7, 13-14, 22-27, 46-51, 54-55, 57-68, and 72-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiCecco in view of Focsaneanu (5610910).**

Regarding claims 46, 54, and 57, DiCecco does not explicitly indicate an input for receiving call identification information in a first format from the originating network; reformatting means for reformatting the received call identification information into a second format; an output for outputting the call identification information in the second format over the terminating network. Focsaneanu discloses a network hybrid, which allows for multiple dissimilar networks, in a computer network that included negotiating optimal transfer protocols (Column 12, lines 13 – 16). In the network, Focsaneanu teaches an input for receiving call identification information in a first format from the originating network; reformatting means for reformatting the received call identification information into a second format; an output for outputting the call identification information in the second format over the terminating network (Column 4, line 65 – Column 5, line 12; Column 13, lines 50 – 53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Focsaneanu's teachings of format conversion in DiCecco's teaching of end-user capability negotiation to allow dissimilar service, terminals, and network elements to communicate (Column 13, lines 50 – 53).

Regarding claim 47, the combination of DiCecco and Focsaneanu discloses an interworking function wherein said reformatting means for reformatting the received call

identification information into a second format is located in said interworking function (Focsaneanu, Column 5, lines 4 – 6).

Regarding claims 48 and 55, the combination of DiCecco and Focsaneanu discloses establishing a speech connection between the calling and recipient terminals if no appropriate signaling from the originating can be identified (Focsaneanu, Column 9, lines 41 – 49).

Regarding claim 49, the combination of DiCecco and Focsaneanu discloses terminating the call if no appropriate signaling from the originating network can be identified (DiCecco, Column 3, line 67 – Column 4, line 20).

Regarding claim 50, the combination of DiCecco and Focsaneanu discloses establishing a speech connection between the calling and recipient terminals if the bearer capabilities of the originating network and the recipient terminal are not compatible (Focsaneanu, Column 9, lines 41 – 49).

Regarding claim 51, the combination of DiCecco and Focsaneanu discloses terminating the call if the bearer capabilities of the originating network and the recipient terminal are not compatible (DiCecco, Column 3, line 67 – Column 4, line 20).

Regarding claims 2 and 22, the combination of DiCecco and Focsaneanu discloses that the call identification information comprises call type information (DiCecco, Column 2, lines 19 – 27; Column 1, lines 14 – 25).

Regarding claims 3 and 23, the combination of DiCecco and Focsaneanu discloses that the call type information comprises telecommunications service information (DiCecco, Column 2, lines 19 – 27; Column 1, lines 14 – 25).



Regarding claims 4 and 24, the combination of DiCecco and Focsaneanu discloses that the call identification information comprises bearer service information (DiCecco, Column 2, lines 19 – 27; Column 1, lines 14 – 25).

Regarding claims 5 and 25, the combination of DiCecco and Focsaneanu discloses that the reformatting means for reformatting the received call identification information is arranged to negotiate the bearer of the terminating network to match that of the originating network (Focsaneanu, Column 4, line 65 – Column 5, line 12; Column 13, lines 50 – 53).

Regarding claims 6, 26, and 75, the combination of DiCecco and Focsaneanu discloses that the first format is an in-band format (Focsaneanu, Column 9, lines 3 – 5).

Regarding claims 7, 27, and 77, the combination of DiCecco and Focsaneanu discloses that the second format is an out-band format (Focsaneanu, Column 9, lines 3 – 5).

Regarding claims 13 and 64, the combination of DiCecco and Focsaneanu discloses that the switch is a mobile switching center of a wireless communication network (Focsaneanu, Column 4, lines 40 – 45).

Regarding claim 14, the combination of DiCecco and Focsaneanu discloses that comprising a transcoder (Focsaneanu, Column 8, lines 11 – 26).

Regarding claim 58, the combination of DiCecco and Focsaneanu discloses that the terminating network is digital (Focsaneanu, Column 4, lines 42 – 45).

Regarding claim 59, the combination of DiCecco and Focsaneanu discloses that the originating network is analogue (Focsaneanu, Column 4, lines 42 – 45; Column 5, lines 51 – 52).

Regarding claim 60, the combination of DiCecco and Focsaneanu discloses that one of the networks is a wireless communications network (Focsaneanu, Column 4, lines 42 – 45).

Regarding claim 61, the combination of DiCecco and Focsaneanu discloses that the wireless communication network is a universal mobile telecommunications system (UMTS) network (Focsaneanu, Column 4, lines 42 – 45).

Regarding claim 62, the combination of DiCecco and Focsaneanu discloses that the wireless communication network is a GSM network (Focsaneanu, Column 4, lines 42 – 45).

Regarding claim 63, the combination of DiCecco and Focsaneanu discloses that the wireless communications network is the terminating network (Focsaneanu, Column 4, lines 42 – 45).

Regarding claim 65, the combination of DiCecco and Focsaneanu discloses that one of the networks is a fixed line network (Focsaneanu, Column 4, lines 42 – 45).

Regarding claim 66, the combination of DiCecco and Focsaneanu discloses that the fixed line network is a PSTN network (Focsaneanu, Column 4, lines 42 – 45).

Regarding claim 67, the combination of DiCecco and Focsaneanu discloses that the fixed line network is an ISDN network (Focsaneanu, Column 4, lines 42 – 45).

Regarding claim 68, the combination of DiCecco and Focsaneanu discloses that the fixed line network is the originating network (Focsaneanu, Column 4, lines 42 – 45).

Regarding claim 76, the combination of DiCecco and Focsaneanu discloses that the terminating network is digital (Focsaneanu, Column 4, lines 42 – 45).

Regarding claims 72, 73, and 74, the combination of DiCecco and Focsaneanu discloses that the call identification information comprises bearer service information (DiCecco, Column 2, lines 19 – 27; Column 1, lines 14 – 25).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-7, 13-14, 21-27, and 44-77 have been considered but are moot in view of the new ground(s) of rejection.

### ***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent No. 6452922 issued to Ho, because it discusses converting and negotiating protocols in a telecommunication network.

U. S. Patent No. 5420916 issued to Sekiguchi, because it discussess a switch that converts protocols in a network.

U. S. Patent No. 5841985 issued to Jie, because it discusses converting protocols.

U. S. Patent No. 6195358 issued to Bowater, because it discusses converting telephone signals.

U. S. Patent No. 6104928 issued to Waugh, because it discussess a network switch that performs protocol conversion.

U. S. Patent No. 6069947 issued to Evans, because it discusses a network switch that setups up network communications.

U. S. Patent No. 6339594 issued to Civanlar, because it discusses a network gateway that converts voice and data communications.

U. S. Patent No. 6181940 issued to Rune, because it discusses negotiating protocols in a telecommunication network.

U. S. Patent No. 6125122 issued to Favichia, because it discusses negotiating communications with mobile switching centers.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Bates whose telephone number is (703) 605-0633. The examiner can normally be reached on 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KB

KB  
July 12, 2004.

  
**HOSAIN ALAM**  
SUPERVISORY PATENT EXAMINER